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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Cervantes)	Art Unit: 2624
)	
Serial No.: 10/758,662)	Examiner: Daley
)	
Filed: January 15, 2004)	HSJ920030236US1
)	
For: SELF-CONTAINED OCR SYSTEM USING HARD)	August 6, 2008
DISK DRIVE)	750 B STREET, Suite 3120
)	San Diego, CA 92101
)	

APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

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(1) Real Party in Interest

The real party in interest is Hitachi Global Storage Technologies, Netherlands, B.V.

(2) Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3) Status of Claims

Claims 1, 3-5, and 7 are pending and finally rejected, and all rejections are appealed. Claims 2, 6, and 8-17 have been canceled.

(4) Status of Amendments

No amendments are outstanding.

(5) Summary of Claimed Subject Matter

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

The sole independent claim at issue (Claim 1) recites a self-contained character recognition system that includes a housing (reference numeral 12 in the Figure; page 3, line 10) that is configured for receiving paper documents. A scanner (reference numeral 14 in the Figure 1; page 3, line 11) is in the housing for

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outputting a digitized representation of information on the paper document. Also, a processor (reference numeral 20 in the Figure; page 3, line 18) is in the housing and executes a character recognition module (reference numeral 18 in the Figure; page 3, line 17) for converting the digitized representation into electronic text. A HDD (24 in the Figure; page 4, line 3) is in the housing for storing the electronic text. The processor automatically executes the character recognition module upon scanning a document and stores the electronic text in the HDD, without the need for a user command, so that the system does not have a user input device, page 4, line 16 - page 5, line 3.

(6) Grounds of Rejection to be Reviewed on Appeal

a. Claims 1, 4, 5, and 7 have been rejected under 35 U.S.C. §103 as being unpatentable over Mangerson, USPN 6,504,138 in view of Han et al., USPP 2002/0051242.

b. Claim 3 has been rejected under 35 U.S.C. §103 as being unpatentable over Mangerson in view of Han et al. and Sasaki, USPN 5,674,012.

(7) Argument

As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner's answer should be "rare", and should be levied only in response to such things as newly presented arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be approved

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by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, id., page 49979.

a. Obviousness Rejections of Claims 1, 4, 5, and 7

The allegation in the Office Action on page 3, first paragraph that Mangerson does not have a user input device is clearly erroneous. Mangerson has one and needs one. Specifically, in col. 8, lines 25-32 Mangerson clearly intends that OCR can be selectively triggered by a user input and indeed a keyboard/mouse controller 144 and keyboard BIOS ROM 145 are provided, see Mangerson, figure 1 and col. 4, lines 20-26 and 48-52. Thus, not only is the allegation underlying the rejections clearly erroneous as a matter of fact, any modification to Mangerson that would omit the keyboard/mouse would prevent OCR triggering by a user as intended by Mangerson and thus would be improper, MPEP §2143.01 (citing In re Gordon). The rejections are overcome.

This has been responded to on page 4 of the Office Action, last two lines by alleging that Mangerson, col. 8, lines 26 and 27 teach that the user input device is optional. Incorrect. Mangerson does not teach or suggest that its input device is optional. Lines 26 and 27 of col. 8 teach that a "prompt for user action is provided at step 522 (i.e., a user or software is queried for the next action to occur), and based upon the result of the prompt, any one or more of the following steps may be executed." However, the examiner conveniently omits the preceding passage of Mangerson that causes the "prompt" - deactivation of the scanner in response to a determination that the storage medium has been removed. Thus, it is only under these limited circumstances that either a user is prompted for action, or software is prompted, but this in no way rises to

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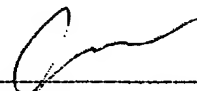
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a suggestion that the remainder of Mangerson's operation, which depends on receiving user input, can for some reason survive without a user input device.

b. Obviousness Rejection of Claim 3

Claim 3 inherits the patentability of its base claim and thus is patentable.

Respectfully submitted,



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APPENDIX A - APPEALED CLAIMS

1. A self-contained character recognition system, comprising:
 - a housing configured for receiving at least one paper document;
 - a scanner in the housing outputting a digitized representation of information on the paper document;
 - a processor in the housing and executing a character recognition module for converting the digitized representation into electronic text; and
 - at least one hard disk drive (HDD) in the housing for storing the electronic text, wherein the processor automatically executes the character recognition module upon scanning a document and stores the electronic text in the HDD, without the need for a user command, the system not having a user input device.
3. The system of Claim 1, wherein the HDD includes a HDD controller and at least one data storage disk.
4. The system of Claim 1, wherein the HDD is removable from the housing.
5. The system of Claim 1, further comprising an output bus on the housing for transferring data on the HDD to an external computing device.
7. The system of Claim 1, further comprising:
 - at least one output device on the housing.

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APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

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APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

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